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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,672	04/16/2004	Hiroyuki Suzuki	Q81115	8646

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EXAMINER

SCHILLING, RICHARD L

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/825,672	Applicant(s) SUZUKI ET AL.	
	Examiner Richard L. Schilling	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 1604.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 10/084,946.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4-16-04</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 11-13 are rejected under the first paragraph of 35 U.S.C. § 112 as being based on insufficient disclosure. The specification fails to show one skilled in the art how to make gold sulfide colloids by the methods of the instant claims except for methods wherein colloidal gold sulfide is made by reacting compounds of Formula 2 with water soluble sulfur compounds in a protective colloid. The instant claims do not require the essential ingredient of a water soluble sulfur compound or the reaction thereof with the compounds of Formula 2.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability

shall not be negatived by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Masutomi et al., Yamashita et al. or Budz et al. Masutomi et al. (see particularly column 2, line 50 - column 3, line 12; column 5, lines 35-51) discloses silver halide emulsions chemically sensitized with colloidal gold sulfide. Yamashita et al. (see particularly column 6, lines 12-35) and Budz et al. (see particularly column 28, line 23 - column 29, line 9; column 9, lines 7-19) discloses silver halide emulsions chemically sensitized with colloidal gold sulfide. If the applied prior art does not anticipate the instant claims, then it would at least be obvious to one skilled in the art that the colloidal gold sulfide of the applied prior art is essentially the same as the colloidal gold sulfide of instant claim 13. Also, how the colloidal gold sulfide which is present in instant claim 13 is prepared is not clear since only one reactant, e.g. Formula 2 compound, is specified. Instant claim 13 does not require the presence of any byproducts of compound Formula 2 in the claimed silver halide emulsions.

3. Hill is cited of interest in the art as disclosing compounds within the scope of Formula 2 of instant claim 11.

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Japanese Publication 4-342249 is cited of interest in the art as disclosing silver halide emulsions containing gold sulfide. The prior art cited by applicants and cited in the parent application has been considered. Lutz et al., the two McVeigh patents and Dunn et al. also disclose silver halide emulsions sensitized with gold sulfide.

4. Any inquiry concerning this communication should be directed to Mr. Schilling at telephone number (571) 272-1335.

RLSchilling:cdc

October 4, 2004

RICHARD L. SCHILLING
PRIMARY EXAMINER
GROUP 4100 1752

